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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,114	12/15/2003	Gerard J. Tate		3648

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EXAMINER

LAVINDER, JACK W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/736,114		TATE, GERARD J.	
	Examiner		Art Unit	
	Jack W. Lavinder		3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 15 and 16 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 15 and 16 are drawn to an alternative species, figure 1, that was not previously claimed

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-16 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 9-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

In claim 9, the limitation in line 13, "a curved top surface resembling a top surface of an upside down spoon," was not disclosed in the original specification or claims or abstract.

In claim 11, the limitation of the lateral cavity is annular was never disclosed in the original specification. The original specification discloses a cylindrical lateral cavity—not annular.

In claim 12, the limitation of the top surface of the vertical post being decorated with a unique color and/or design was never disclosed in the original specification.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9, 10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortune, 5214826 in view of Collins, 3217371.

Regarding claim 9, Fortune discloses a fastener assembly for use with footwear (abstract) comprising a series of fastener elements (figure 15) wherein each fastener element comprises

- A first mating member having two curved stop ends (20) and an elastomeric member (46) having two ends positioned between the two curved stop ends

- Each curved stop end having a vertical cavity (24, figure 4) with spaces for receipt of the first and second enlarged diameter areas of the vertical post (38)
- Two second mating members (figure 10) comprising a vertical post having a flange (40), a first area of enlarged diameter (see top portion of post 38), and a second area of enlarged diameter (portion located between sections 42 and 44)

The shape of the first and second enlarged diameter areas are considered to read on the limitations defined in the last paragraph of claim 1, i.e., they are shaped for an adult to easily push the post into the cavities and are difficult for a young child to remove the post from the vertical cavity.

Fortune fails to disclose a curved end stop having a top surface resembling the top surface of an upside down spoon and fails to disclose a proximal end of the stop end having a hollow lateral cavity to receive an end of the elastomeric member.

Fortune discloses a flat top surface and the reverse attachment between the elastomeric member (46) and the end stops (20), i.e., the elastomeric member has a cylindrical cavity that receives a cylindrical stud (26) to secure the end stop to the elastomeric member. Applicant's invention has the reversed attachment means, i.e., the cylindrical cavity is located on the end stop and the cylindrical stud on the elastomeric means.

Collins discloses a curved top surface (80) on an end stop and a cavity (72, 74) for receiving an elastomeric member (60, figures 1-3). This type of attachment between

Art Unit: 3677

the end stop and the elastomeric member is considered to be a design equivalent of Fortune's attaching arrangement. Both attaching arrangements perform the same function of attaching the end stop to the elastomeric member equally as well as the other. Furthermore, the specification fails to disclose any criticality associated with the claimed attaching arrangement.

It would have been an obvious design choice to a person having ordinary skill in the art to modify Fortune's attaching arrangement to have the cavity located on the end stop for the reasons indicated above. Furthermore, to make Fortune's top surface of the end stop in the shape of a curve would have been obvious to a person having ordinary skill in the art in order to improve the aesthetical appearance of the end stop in view of the teachings in Collins.

Regarding claim 10, Fortune discloses cylindrical shaped posts (figure 7).

Regarding claims 12-14, Fortune discloses that the elastomeric member and the end stops can be made in any color, preferably neon colors (col. 4, lines 38-41, col. 7, lines 58-61).

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tonai discloses an elastic shoe lace incorporating hooks on the ends of an elastic member in order to engage the eyelets of a shoe.

Response to Arguments

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Art Unit: 3677

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack W. Lavinder
Primary Examiner
Art Unit 3677

5/11/05